



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/378,046 08/20/99 MANFREDI

J CPI-088

000959
LAHIVE & COCKFIELD
28 STATE STREET
BOSTON MA 02109

HM12/0220

EXAMINER

BRANNOCK, M

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 02/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/378,046

Applicant(s)
Manfredl et al.

Examiner
Michael Brannock, Ph.D.

Group Art Unit
1646



☒ Responsive to communication(s) filed on Apr 27, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-47 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-47 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1646

DETAILED ACTION

Election/Restriction

1. Applicant is notified that this Office Action vacates and replaces the previous Office Action (Paper 7, 12/4/00). Applicant is required to respond to this Office Action only.
2. Claims 1-47 are generic to a multitude of disclosed patentably distinct inventions, each such invention comprising a a single characteristic of each of the following I-IV:
 - I. specific cell type, e.g. yeast or mammalian.
 - II. specific receptor protein, e.g. β_2 -adrenergic receptor or STE2
 - III. specific biochemical pathway, e.g. a particular MAPK pathway, e.g., yeast pheromone response pathway.
 - IV. specific heterologous DNA construct that encodes a polypeptide that activates a signal transduction pathway.

Classification of these products is dependent on the specific examples chosen from groups I-IV.

3. The inventions are distinct, each from the other because of the following reasons:

Each cell, having one characteristic from each of Groups I-IV, represents a patentably distinct product. Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products appear to constitute patentably distinct inventions because each of the different products require different starting materials and operate through mechanisms that are distinct from the others. Further one product is not required for the use of

Art Unit: 1646

any other. Although a search of any one product may overlap that of another, a search of one could not be relied upon to provide art that is anticipatory, or would render obvious, any other.

Therefore, a search and examination of all the products in one patent application would result in an undue burden, since the searches for the groups are not co-extensive, the classification is different, and the subject matter is divergent.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species type A: each species comprising a specific signal to be amplified, including particular reporter gene constructs.

Species type B: each species comprising a specific mutation in a particular gene/protein participating in the signal transduction pathway.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed embodiment of the instant invention, such embodiment consisting of only those components which would be present in **one particular** cell, even though this requirement is traversed. Applicant is required to elect a single example from Species A, and a single example of Species B for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, all claims are generic.

Art Unit: 1646

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1646

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Thursdays from 8:00 a.m. to 5:30 p.m. The examiner can also normally be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564.


Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB



January 29, 2001



YVONNE EYLER, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600